

REMARKS

This Response, filed in reply to the Office Action dated July 21, 2006, is believed to be fully responsive to each point of rejection raised therein. Accordingly, favorable reconsideration on the merits is respectfully requested.

Claims 1-53 remain pending in the application. Claims 1-28, 30, 32, 34 and 36-53 stand rejected under 35 U.S.C. § 103 as being unpatentable over Palmer in view of Lavery. Claims 29, 31, 33 and 35 have been rejected under 35 U.S.C. § 103 as being unpatentable over Palmer in view of Lavery and further in view of Warmus. All references are previously of record. Applicant respectfully submits the following arguments in traversal of the rejections.

As an initial matter, the Examiner generally relies on the page formatting process description at cols. 5-6 of Palmer for teaching basic aspects of independent claim 1. Applicant emphasizes that Palmer teaches solely the presentation of variable data within a variable data area of a base document. To the extent that Palmer includes a dummy region, the dummy region corresponds to a shaded portion to indicate a place where data is to be inserted. See Fig. 6C, area 132 and col. 6, lines 9-18. The dummy data itself identifies the variable data that a user desires to insert into a dummy data region. Col. 5, lines 15-17. Thus, the dummy data comprises a filename corresponding to data stored in database 48. Col. 6, lines 40-44. Dummy variable data within a dummy data region is replaced, by the formatting extension (42), with page description language prolog (88), which are format parameters (column 6, lines 9-12). Significantly, the extension and prolog are not subject to raster processing (col. 5, line 65 to col. 6, line 8). Accordingly, the dummy data itself corresponds coding information, filename

information and extension codes. As the data is ignored by a raster image process, it is clear that such codes are not image data for editing.

The Examiner contends that Palmer teaches that the dummy parts data comprises an embedded image for editing. However, it is clear that Palmer teaches that the dummy data comprises a set of fields or identifiers for insertion of data from a database 48. Accordingly, the dummy data is not image data embedded for editing. Rather, the data is referential data for a file or referential data for a format and is not image data for editing. To the extent that the Examiner cites a placeholder function for the dummy data, there is no clear teaching that the placeholder (e.g. shaded box of Fig. 6C) is edited.

As a related matter, it is further noted that claim 1 describes that the dummy parts data is of a same image size as a corresponding unreceived part. The Examiner contends that in order provide its placeholder function, the dummy data must be of the same size as the unreceived part. Applicant submits that this rationale cannot support the rejection for at least the following three reasons.

First, the Examiner is merely speculating as to the size of the dummy data in relation to data of the unreceived part. However, rejections must be based on necessity of a claim element occurring in a reference and not merely a probability that the claim element may occur. In this case, the Examiner's rationale is merely speculative and thus cannot sustain the rejection. In re Robertson, 49 USPQ2d 1949, 1951 (Fed. Cir. 1999).

Second, the Examiner's contention that the size of the dummy parts data must be coextensive with the size of the unreceived part in order to provide a placeholder function is

incorrect. The placeholder function, i.e. setting a position of inserted data, can be provided by the setting of a code or field without necessarily establishing the size to coincide with that of the unreceived part. In this regard, the Examiner's own recognition that scaling can occur to fit the data would suggest that the dummy data may not coincide with the unreceived part.

Third and finally, if the scaling is applied to data as a form of editing, then the editing is clearly on a data that is already received. Accordingly, such data would not be dummy parts data which corresponds to unreceived data, or data not yet received for the page.

The Examiner further cites Lavery for teaching automation of the process and high resolution substitution of image data. However, Lavery does not make up for the above deficiencies of Palmer. Therefore, claim 1 is patentable for at least the above reasons. Independent claims 11 and 21-22 are patentable for analogous reasons. The remaining claims are patentable based on their dependency as the additional reference Warmus does not make up for the deficiencies of the primary combination.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

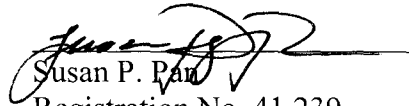
RESPONSE UNDER 37 C.F.R. § 1.116
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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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